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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,226	08/02/2001	Yi Zhao	17432 (HL)	8912
23601	7590	10/03/2003	EXAMINER	
CAMPBELL & FLORES LLP 4370 LA JOLLA VILLAGE DRIVE 7TH FLOOR SAN DIEGO, CA 92122			BASI, NIRMAL SINGH	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,226

Applicant(s)

ZHAO ET AL.

Examiner

NIRMAL BASI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims **1-34**, drawn to a method for identifying an effective agent that modulates a biological activity of a nuclear hormone receptor, classification dependent upon agent structure.
  - II. Claim **35**, drawn to a method for identifying an improved agent that modulates a biological activity of a nuclear hormone receptor, classification dependent upon agent structure.
  - III. Claims **36-68**, drawn to a method for identifying an effective agent that modulates a *protein kinase A activity* associated with a nuclear hormone receptor, classification dependent upon agent structure.
2. The inventions are distinct, each from the other because of the following reasons:
3. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive Inventions that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Inventions I, II, and III are directed to methods that are distinct both physically and functionally, and are not required one for the other. Invention I requires search and consideration of an *effective agent* that modulates a biological activity of a nuclear hormone receptor, which is not required by any of the other Inventions. Invention II requires search and consideration of an *improved agent* that modulates a biological activity of a nuclear hormone

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receptor, which is not required by any of the other Inventions. Invention III requires search and consideration of an *effective agent* that modulates *protein kinase A activity* associated with a nuclear hormone receptor, which is not required by any of the other Inventions.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Retinoid X receptor (RXR)
  - b. Hepatocyte nuclear factor 4 (HNF4)
  - c. Testicular Receptor
  - d. Tailless gene homolog (TLX)
  - e. Chicken ovalbumin upstream promoter transcription factor (COUP-TF)
  - f. Thyroid receptor (TR)
  - g. Retinoic acid receptor (RAR)
  - h. Peroxisome proliferator activated receptor (PPAR)
  - i. Reverse Erb (reverb)
  - j. RAR-related orphan receptor (ROR)
  - k. Steroidogenic factor-1 (SF-1)
  - l. Liver receptor homolog-1 (LRH-1)
  - m. Liver X Receptor (LXR)
  - n. Farnesoid X receptor (FXR)
  - o. Vitamin D receptor (VDR)
  - p. Ecdysone receptor (PXR)
  - q. Constitutive androstane receptor (CAR)
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- r. Neuron-derived activated receptor (NOR1)
- s. Nuclear receptor related 1 (NURR1)
- t. Estrogen receptor (ER)
- u. Estrogen-related receptor (ERR)
- v. Glucocorticoid receptor (GR)
- w. Androgen receptor (AR)
- x. Progesterone receptor (PR)
- y. Mineralocorticoid receptor (MR)

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims **10 and 11** are generic.

6. **If applicant selects Invention I, one species from the nuclear hormone receptor group must be chosen to be fully responsive.**

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and/or different classification, restriction for examination purposes as indicated is proper.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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**CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Nirmal Basi** whose telephone number is **(703) 308-9435**. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Yvonne Eyler, Ph.D.** can be reached on **703-308-6564**. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications. The fax phone numbers for the customer service center is 703-872-9305.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

CJN  
September 30, 2003

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600